

## REMARKS

Applicants appreciate the courtesies extended by Examiner Michael V. Meller during an interview on November 19, 2003 with Applicants' attorney, Jeffrey A. Wolfson. The comments appearing herein summarize, and are substantially in accord with, those presented and discussed during the interview.

Initially, Applicants appreciate the Examiner's recognition of the allowance of claims 4 and 15. The Summary sheet to the Office Action erroneously indicates that claims 4 and 15 stand rejected, however, at the interview the Examiner confirmed that these claims stand allowed since they are not rejected in the final Office Action.

Also, Applicants submit herewith a copy of the Form PTO-1449, which was previously submitted on December 6, 2001. This Form PTO-1449 was not properly executed in that the Examiner did not initial reference AK to evidence consideration thereof. Applicants respectfully request that the Examiner properly execute this form including reference AK to provide a clear record in this application.

Claims 4 and 7-15 remain pending in the subject application. Claims 7-14 were previously withdrawn over Applicant's traversal pursuant to a seven (7) way restriction requirement that was made final in the final Office Action. The position of the Patent Office, as stated on page 2 of the final Office Action, is that there are many different ways of using the claimed compound, which evidences that the search encompasses many different areas and is quite extensive. The Examiner indicated at the Interview that, in spite of several MPEP provisions stating that dependent claims are to be allowed when the independent genus or linking claim stands allowed, the Applicants could either file a Petition regarding the restriction or cancel the previously withdrawn claims 7-14 to receive a patent with claims 4 and 15. In the latter case, if examination of the withdrawn claims is desired the Examiner stated that Applicants would need to file a divisional application that would be restricted into five (5) separate groups.

Regardless of the characterization of allowed independent product claim 4 as being generic or linking, or neither, Applicants respectfully recommend **MPEP § 821.04** to the Examiner's attention. In particular, MPEP § 821.04 states that "if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined" (emphasis added). Since product claims 4 and 15 were elected, and withdrawn process claims 7-14 all depend from allowed product claim 4, Applicants respectfully submit that the Patent Office will now rejoin the dependent claims.

Moreover, Patent Office procedure according to MPEP § 821.04 is that "[p]rocess claims which depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance" (emphasis added). That is the exact situation in this application. Applicants presented dependent claims 7-14 in a Preliminary Amendment even before any examination occurred in this application, in an attempt to expedite the examination as requested by MPEP § 821.04. In view of MPEP § 821.04, Applicants have herein indicated all claims as being "Previously Presented," rather than "Withdrawn" or "Canceled," and respectfully submit that claims 4 and 7-15 are now pending *as a matter of right* for the Examiner's further examination or allowance.

Accordingly, Applicants believe that the entire application is now in condition for allowance, early notice of which would be appreciated. Should the Examiner not agree with the Applicants' position, then a personal or telephonic interview is respectfully requested to discuss any remaining issues and expedite the eventual allowance of the application.

Respectfully submitted,

Dec. 1, 2003  
Date

Jeffrey A. Wolfson  
Jeffrey A. Wolfson (Reg. No. 42,234)  
For: Allan A. Fanucci (Reg. No. 30,256)

**WINSTON & STRAWN LLP**  
**Customer Number: 28765**

(202) 371-5770

**LIST OF REFERENCES CITED BY APPLICANT**  
(Use several sheets if necessary)

ATTY. DOCKET NO.:

87264-100

APPLICATION NO.:

09/880,498

APPLICANT:

J. MARTINEZ et al.

FILING DATE:

June 13, 2001

GROUP:

1645

**U.S. PATENT DOCUMENTS**

*EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS	FILING DATE IF APPROPRIATE
	AA						
	AB						
	AC						
	AD						
	AE						
	AF						
	AG						
	AH						
	AI						
	AJ						

**FOREIGN PATENT DOCUMENTS**

		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION	
							YES	NO
	AK	WO 95/14666	6/1995	PCT				
	AL							
	AM							
	AN							

**OTHER REFERENCES** (Including Author, Title, Date, Pertinent Pages, Etc.)

	AO	McDowell, R.S., et al., "Growth hormone secretagogues: characterization, efficacy, and minimal bioactive conformation," Proc. Nat'l Acad. Sci. USA, 92 (24): 11165-11169 (1995). (Abstract)
	AP	Patchett et al., A.A., "Design and biological activities of L-163,191 (MK-0677): A potent, orally active growth hormone secretagogue," Proc. Nat'l Acad. Sci. USA, 92 (15): 7001-7005, July 1995.
	AQ	Muccioli, G., et al. "Tissue Distribution of GHRP Receptors in Humans," Abstracts IV European Congress of Endocrinology, Sevilla, Spain, 1998.
	AR	Deghenghi R., et al., "Impervious peptides as growth hormone secretagogues," Pept. Sci.: Present, Future, Proc. Int. Pept. Symp., pp. 411-412, 1999. (Abstract)

**EXAMINER****DATE CONSIDERED**

\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with **MPEP 609**; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.